



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,997	12/16/1999	LOU W. WATKINS	4642	8340

7590 02/04/2002
SAMUELS GAUTHIER & STEVENS LLP
225 FRANKLIN STREET
SUITE 3300
BOSTON, MA 02110

EXAMINER
BAREFORD, KATHERINE A

ART UNIT	PAPER NUMBER
1762	5

DATE MAILED: 02/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/464,997	Applicant(s) Watkins
Examiner Katherine A. Bareford	Art Unit 1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Jan 23, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 4, 5, 8-10, and 12 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Claims 2-3, 6-7, 11 and 13-17 are canceled.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) Interview Summary (PTO-413) Paper No(s). _____

19) Notice of Informal Patent Application (PTO-152)

20) Other: _____

Application/Control Number: 09/464,997

Art Unit: 1762

Application

1. The amendment of Jan. 23, 2002 (cert. of mailing date Dec. 17, 2001) has been received and entered.

Election/Restriction

2. Applicant's election of Group I, claims 1-12 in Paper No. 12 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. The Examiner notes the cancellation of nonelected claims 13-17.

Specification

4. The title of the invention is now descriptive.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Application/Control Number: 09/464,997

Art Unit: 1762

6. Claims 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8, line 1, "rapidly" should be deleted to correspond to the amendment to claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The rejection of claims 1, 3, 7, 9 and 11 under 35 U.S.C. 102(b) as being anticipated by EP 380 163 A2 (hereinafter '163) is withdrawn due to applicant's amendments to the claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Application/Control Number: 09/464,997

Art Unit: 1762

10. Claims 1, 8-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 380 163 A2 (hereinafter '163) in view of Doucet (US 4364882).

'163 teaches a method of applying a syntactic foam insulation to a length of pipe. Column 1, line 30 through column 4, line 10. An inner syntactic foam insulator and an outer protective cover are co-extruded around the length of pipe. Column 2, lines 2-20 and column 3, lines 5-45 and figures 3-4. The cover is rapidly solidified. Column 3, lines 35-45. This retains the foam in a desired shape about the length of pipe. Column 3, lines 35-45 and figures 3-4.

Claim 9: '163 teaches a method of applying a syntactic foam insulation to a length of pipe.

Column 1, line 30 through column 4, line 10. An inner syntactic foam insulator and an outer protective cover are co-extruded around the length of pipe. Column 2, lines 2-20 and column 3, lines 5-45 and figures 3-4. The cover is rapidly solidified. Column 3, lines 35-45. This retains the foam in a desired shape about the length of pipe. Column 3, lines 35-45 and figures 3-4.

'163 teaches all the features of these claims except (1) the thermoplastic resin and (2) the air cooling (claims 8 and 12).

However, Doucet teaches a method of applying a foam insulation to a length of pipe. Column 2, lines 15-40 and column 3, lines 5-25 and figure 1. An inner foam insulator and an outer protective cover are co-extruded around a length of pipe (co-extruded with the foam and cover). Column 2, lines 15-40 and column 3, lines 5-25 and figure 1. The cover is rapidly solidified. Column 2, lines 60-65. This retains the foam in a desired shape about the length of pipe.

Application/Control Number: 09/464,997

Art Unit: 1762

pipe. Column 2, lines 15-40 and 60-65, column 3, lines 5-35 and figure 1. The cover material is a thermoplastic. Column 3, lines 5-10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '163 to use a thermoplastic as taught by Doucet with an expectation of similar results, because '163 teaches forming a three layer pipe with an inner layer, a foam intermediate layer and an outer layer by extrusion, and Doucet teaches that when forming a three layer pipe with an inner layer, a foam intermediate layer and an outer layer by extrusion, it is conventionally known to use a thermoplastic outer layer. It further would have been obvious to provide air cooling, because if no other form of cooling was used, the air contact after extrusion would allow the product to cool.

11. Claims 4-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 380 163 A2 in view of Doucet as applied to claims 1, 8-9 and 12 above, and further in view of Francis (US 4773448).

'163 in view of Doucet teaches all the features of these claims except the water bath cooling.

However, Francis teaches a method of making a plastic pipe with a hard outer shell and an inner foam layer. Column 2, lines 5-45. Francis teaches cooling the pipe with a water bath to solidify the pipe after extrusion. Column 2, lines 25-35. The outer layer of the pipe can be made of polyvinyl chloride. Column 2, lines 33-40.

Application/Control Number: 09/464,997

Art Unit: 1762

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '163 in view of Doucet to use water bath cooling as taught by Francis with an expectation of similar results, because '163 in view of Doucet teaches forming a multilayer pipe by extrusion and cooling, and Francis teaches that when forming a multilayer pipe by extrusion, it is conventionally known to use a water bath to cool the extruded material.

12. Hornbeck (US 4465449) and Conlon (US 4322260) teach making extruded pipe.

Response to Arguments

13. Applicant's arguments filed Jan. 23, 2002 have been fully considered but they are not persuasive.

As to the combination of '163 and Doucet, applicant argues that '163 does not disclose the use of a thermoplastic, and that one of ordinary skill in the art would not look to Doucet to replace the thermoset of '163 with the thermoplastic of Doucet. According to applicant, Doucet does not disclose or suggest the use of syntactic foam insulation or anything to do with thermally insulated pipes of the type disclosed in '163 and the present application. Thus, a person working in the field of thermal insulation for pipelines would not look to the field of below ground sewage pipes, and thus, the references are not properly combinable.

The Examiner has reviewed these arguments, however, the rejection is maintained. Applicant has essentially argued that Doucet is nonanalogous art to '163 and the present

Application/Control Number: 09/464,997

Art Unit: 1762

application. However, in response to this that Doucet is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Doucet is, at the least, reasonably pertinent to the particular problem with which applicant is concerned. Doucet, '163 and applicant are all concerned with the overall problem of providing a pipe with an outer plastic layer over an inner foam layer which is placed on the wall of the pipe. '163 and Doucet both provide methods of providing such a pipe. Thus, one of ordinary skill in the art would clearly look to this similarly constructed pipe.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, CFR 1.136(a) will be calculated from the mailing date of the advisory action.

Application/Control Number: 09/464,997

Art Unit: 1762

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on Monday-Thursday from 7:00 am to 4:30 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck, can be reached on (703) 308-2333.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KATHERINE A. BAREFORD
PRIMARY EXAMINER
GROUP 1100-1700